UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 September 2008</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-3,5-9,11-18 and 20-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3,5-9,11-18 and 20-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/15/2008</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This action is responsive to Applicants' amendment received 25 September 2008.

2.   Claims 1-3, 5-9, 11-18, and 20-27 are pending and have been examined.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1, 5-9, 12-14, 16, 20-24, 26, and 27 are rejected under 35 U.S.C. §102(b) as being

anticipated by Bahreman (US 6,061,665).

5.   As to claim 1, Bahreman shows:

        a.   A computer-implemented method comprising:

        b.   receiving, at a communications module **350**, consumer information (weighting of

payment methods) associated with a consumer (Client) (Column 10, lines 43-62);

        c.   identifying at least one approved payment option from a plurality of payment

options (one or more messages corresponding to payment protocols, Id.)

utilizing the consumer information, the at least one payment option being valid for the

consumer (mutually acceptable, Id.);

d.   generating, at an approved payment options generator, a list of approved payment

options ("the list of payment capabilities," Columns 14-15, lines 64-1), the list including

the at least one approved payment option (the approved option is picked from the list);

e.   communicating the at least one approved payment option to the consumer for

selection by the consumer (the list is communicated to the client, Column 10, lines 43-

62); and

f.   requesting, via a selections module, that the consumer selects a payment option

from the list (both the client, or consumer, and the merchant pick, through a weighting, a

payment option or multiple payment options they prefer. Id.).

6.   As to claim 5, Bahreman further shows:

storing the approved payment option for the consumer for use in future transactions

(Column 15, lines 16-24).

7.   As to claim 6, Bahreman further shows:

the plurality of available payment options include at least one of a credit card option, a

phone bill option, an ACH option, a payment by check option, a direct bill option,

and a prepayment option (Column 1, lines 22-33).

8.   As to claim 7, Bahreman further shows:

identifying the at least one approved payment option to the consumer includes identifying

a payment option utilizing vendor payment option preference (weighting is by

client and merchant, Column 10, lines 43-62).

9.   As to claim 8, Bahreman shows:

g.   A system comprising:

h.   a communication module **350** to receive consumer information(weighting of

payment methods by client, Column 10, lines 43-62);

i.   an approved payment options generator module **360** to:

j.   select, from a plurality of payment options (stored in Figure 3, element 394), at

least one approved payment option (mutually acceptable, Column 10, lines 43-62),

utilizing the consumer information, and

k.   generate a list of at least one approved payment options ("the list of payment

capabilities," Columns 14-15, lines 64-1),, the list of approved payment options including

the selected at least one approved payment option utilizing the consumer information (the

approved option is picked from the list); and

l.   a selection module **320** to present the consumer with an option to select a payment

option

from the list of at least one approved payment options (discussed in, Column 15, lines 26-

50).

10.   As to claim 9, Bahreman further shows:

the option includes providing additional consumer information ("It may also need input

from the user", Id.).

11.   As to claim 12, Bahreman further shows:

the plurality of available payment options include at least one of a credit card option, a

phone bill option, an ACH option, a payment by check option, a direct bill option,

and a prepayment option (Column 1, lines 22-33).

12.   As to claim 13, Bahreman further shows:

the payment options rules engine is to identify a payment options presentation format,

utilizing vendor payment option preference (weighting is by client and merchant,

Column 10, lines 43-62).

13.   As to claim 14, Bahreman shows:

m.   A computer-implemented method comprising:

n.   providing, via network equipment, consumer information (weighting of payment

methods) associated with the consumer (client)to a transaction processing facility (credit

cards are inherently processed by a facility other than the merchant as are checks and

ACH transactions) (Column 10, lines 43-62);

o.   receiving at least one approved payment option (mutually acceptable, Id.) selected

from a plurality of payment options from the transaction processing facility (comprising

options "the client and the merchant are equipped to process efficiently and securely"

Id.),

p.   the at least one approved payment option identified based on the consumer

information presenting a list of payment options (both the client, or consumer, and the

merchant provide weighted lists of options, Id.), the list including the at least one

approved payment option to the consumer (if it is picked, it was on both lists); and

q.   requesting, via the network equipment, that the consumer selects an approved

payment option from the list (both the client, or consumer, and the merchant pick,

through a weighting, a payment option or multiple payment options they prefer. Id.).

14.   As to claim 16, Bahreman shows:

r.   A machine-readable medium for embodying a sequence of instructions that, when

executed by the machine, cause the machine to:

s.   receive consumer information (weighting of payment methods) associated with a

consumer (Client) (Column 10, lines 43-62);

t.   identify at least one approved payment option from a plurality of payment options

(one or more messages corresponding to payment protocols, Id.) utilizing the consumer

information, the at least one payment option being valid for the consumer (mutually

acceptable, Id.); and

u.   communicate the at least one approved payment option to the consumer for the

selection by the consumer (the list is communicated to the client, Id.); and

v.   request that the customer selects an approved payment option from a list including

the at least one approved payment option identified based on the consumer information

(both the client, or consumer, and the merchant pick, through a weighting, a payment

option or multiple payment options they prefer. Id.).

15.   As to claim 20, Bahreman further shows:

the approved payment option for the consumer is stored for use in future transactions

(Column 15, lines 16-24).

16.   As to claim 21, Bahreman further shows:

the plurality of available payment options include at least one of a credit card option, a

phone bill option, an ACH option, a payment by check option, a direct bill option,

and a prepayment option (Column 1, lines 22-33).

17.   As to claim 22, Bahreman further shows:

identifying the at least one approved payment option to the consumer includes identifying

a payment option utilizing vendor payment option preference (weighting is by

client and merchant, Column 10, lines 43-62).

18.   As to claim 23, Bahreman shows:

w.   A system comprising:

x.   means for receiving consumer information (weighting of payment methods) (Column 10, lines 43-62);

y.   means for selecting, from a plurality of payment options, at least one approved payment option (mutually acceptable, Id.), utilizing the consumer information (selection is done through the weighting by both parties, Id.);

z.   means for generating a list of at least one approved payment options ("the list of payment capabilities," Columns 14-15, lines 64-1), the list of approved payment options including the selected at least one approved payment option (the approved option is picked from the list) utilizing the consumer information (Column 10, lines 43-62); and

aa.   means for presenting the consumer with an option to select a payment option from the list of at least one approved payment options (both the client, or consumer, and the merchant pick, through a weighting, a payment option or multiple payment options they prefer. Id.).

19.   As to claim 24, Bahreman shows:

bb.   A machine-readable medium for embodying a sequence of instructions that, when executed by a machine, cause the machine to:

cc.   provide consumer information (weighting of payment methods) associated with a consumer to a transaction processing facility (credit cards are inherently processed by a facility other than the merchant as are checks and ACH transactions) (Column 10, lines 43-62);

dd.   receive at least one approved payment option (mutually acceptable, Id.) selected

from a plurality of payment options from the transaction processing facility based on the

consumer information ("the list of payment capabilities," Columns 14-15, lines 64-1), the

at least one payment option being valid for the consumer (to come to an agreement on the

method, it has to be valid for both);

ee.   present the at least one approved payment option to the consumer for selection by

the consumer (if it is picked, it was on both lists); and

ff.   request that the customer selects an approved payment option from a list including

the at least one approved payment option identified based on the consumer

information(both the client, or consumer, and the merchant pick, through a weighting, a

payment option or multiple payment options they prefer. Column 10, lines 43-62).

20.   As to claim 26, Bahreman further shows:

receiving a response to the request that the consumer selects a payment option from the

list (communication is bidirectional to decide on the method, Id.).

21.   As to claim 27, Bahreman further shows:

the response is a selection of a payment option from the list (the selection must be on

both lists to be accepted, Id.).

Claim Rejections - 35 USC § 103

22.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

23.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

24.   Claims 3, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bahreman in view of Dykstra (US 5,611,052).

25.   As to claims 3, 11, and 18, Bahreman shows as discussed above in regards to claims 1, 8,

and 16. Bahreman does not expressly show:

identifying the at least one approved payment option includes generating a reliability score value

utilizing the consumer information.

26.   However, Dykstra shows the evaluation of a reliability score (credit score) of the

consumer prior to approving a loan as a payment method (Abstract). Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention to have modified the

teachings of Bahreman to include the credit score analysis of Dykstra in order reduce the

likelihood of non-payment.

27.   Claims 2, 15, 17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Bahreman.

28.   While the Examiner's primary position is that these claims are inherently shown by

Bahreman, in case it is not inherent, they would be obvious to implement in the manner claimed.

29.   As to claims 2, 15, 17, and 25, Bahreman teaches as discussed above in regards to claims

1, 14, 16, and 24, but does not expressly show:

30.   monitoring a request by the consumer for a further payment option, the further payment

option differing from the at least one approved payment option;

communicating to the consumer a request for additional consumer information; and

selectively approving the request by the consumer for the further payment option based on the

additional consumer information.

31.   However, Bahreman does show the consumer presenting payment options to the

merchant which, if the merchant is capable of using, could end up as the payment option being

used (Column 10, lines 43-62). Bahreman generically discusses the bidirectional communication

between the parties with multiple messages representing different payment options (Id.).

Therefore, if not inherent, it would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified the teachings of Bahreman to implement a manner of

negotiation where, the negotiation does not stop when an acceptable alternative is arrived at, but

continues until the preferred method is established, even if that method is introduced by the

consumer not the merchant. This would allow the greatest level of satisfaction between both

parties as the preferred method takes into account both parties preferences.

32.   The Examiner maintains his position regarding the claimed term "module(s)" as noted in

the Office Action mailed 25 June 2008, paragraph no. 33.

Definitions

33.   The Examiner hereby adopts the following definitions under the broadest reasonable

interpretation standard. In accorance with *In re Morris,* 127 F.3d 1048, 1056, 44 USPQ2d 1023,

1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of

the claims.[1] Additionally, these definitions are only a guide to claim terminology since claim

terms must be interpreted in context of the surrounding claim language. Finally, the following

list is not intended to be exhaustive in any way:

> *Associate*: "4 : to bring together or into relationship in any of various intangible ways (as
>
> in memory or imagination)." Webster's Ninth New Collegiate Dictionary,
>
> Merriam-Webster Inc., Springfield MA, 1986.

> *Computer*: "Any machine that does three things: accepts structured input, processes it
>
> according to prescribed rules, and produces the results as output." Computer
>
> Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

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[1] While most definition(s) are cited because these terms are found in the claims, the Examiner
may have provided additional definition(s) to help interpret words, phrases, or concepts found in
the definitions themselves or in the prior art.

Response to Arguments

34.   Applicant's arguments filed 25 September 2008 have been fully considered but they are not persuasive.

35.   <u>Applicants argue</u>:

36.   "Office action states that the weighting of payment methods correspond to "receiving consumer information associated with a consumer" recited in claim 1. As is evident from the passage reproduced above, the weight is associated with items of different payment processing methods and may be provided by both the client and the merchant. The weights in Bahreman serve to facilitate dynamic negotiation of a mutually acceptable method for processing payments. The weights, therefore, while may be provided by a client in Bahreman, are associated with the items associated with the payment processing methods, bit not with the client. Therefore, Bahreman fails to disclose or suggest "receiving consumer information associated with a consumer" recited in claim 1" (Remarks, Pages 10-11, Paragraph spanning pages).

37.   <u>Examiner's response</u>:

38.   The fact that the consumer's weights are provided by the consumer is more than sufficient to show association according to the above cited definition. As the weights describe consumer preferences, there is clearly a relationship between the consumer and the weights.

39.   <u>Applicants argue:</u>

40.   "It is submitted that a payment protocol is distinct from a payment option and therefore a

"payment protocol" recited in Bahreman does not read on a "payment option" in general or on

"an approved payment option," recited in claim 1, in particular" (Remarks, Page 11, Paragraph

1).

41.   <u>Examiner's response:</u>

42.   While the Examiner agrees there is a fundamental difference between the method and the

protocol, he also sees them as related. Each method has a protocol associated with it. Some

methods may be very similar, such as using different credit cards (Visa, Master Card, American

Express, etc.), but one of ordinary skill could tell the difference according to at least the

communications path and the data being transmitted. For methods that are not so closely related,

the differences in protocols would be more apparent.

43.   <u>Applicants argue:</u>

44.   "Furthermore, references to messages corresponding to payment protocols cannot be

interpreted as disclosing the operation of identifying, from multiple payment option, an option

that is valid for the consumer. It is submitted that negotiation between a client and a merchant of

a mutually acceptable method for processing payments, is a process that is distinct from the

operation of "identifying at least one approved payment option from a plurality of payment

options utilizing the consumer information, the at least one payment option being valid for the

consumer," as recited in claim 1" (Remarks, Page 11, Paragraph 1).

45.   Examiner's response:

46.   The messages themselves are not the identification. However, they are evidence that the

identification of a valid payment option for the consumer was found. If no valid payment option

was found the transaction could not have progressed to the application of the protocol. While the

cited passage does not expressly recite the identification, it does provide sufficient evidence to

show that it is necessarily present.

47.   Applicants argue:

48.   "Bahreman makes no mention of generating of a list in general or of generating of a list

of approved payment options in particular. The Office action refers to the approved option being

picked from the list, while Brennan does not discuss any generated lists of approved payment

options or an operation of picking from such list. Therefore, Bahreman fails to disclose or

suggest "generating a list of approved payment options, the list including the at least one

approved payment option" recited in claim 1" (Remarks, Pages 11-12, Paragraph spanning

pages).

49.   Examiner's response:

50.   The Examiner has modified the citation for this element to more clearly show the list of

approved payment options.

51.   Applicants argue:

52.   "Bahreman fails to disclose or suggest "requesting that the consumer selects a payment

option from the list" recited in claim 1" (Remarks, Page 12, Paragraph 2).

53.   <u>Examiner's response</u>:

54.   While the Examiner believes the cited passage for this limitation is sufficient to show the

limitation, the Examiner also directs Applicants' attention to Column 14, lines 1-9.

Conclusion

55.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

56.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

57.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-

3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

58.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

59.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621